

REMARKS

Entry of the foregoing amendments, and reexamination and reconsideration of the subject application, pursuant to and consistent with 37 C.F.R. § 1.104 and § 1.112 and the Request for Continued Examination filed herewith, and in light of the following remarks, are respectfully requested.

Amendments

Claim 3 has been cancelled and two of the three resin layer compositions recited therein have been incorporated into claim 1.

The reflectance has been amended to the range of 12% to 19% as supported at least by the data in Table 1 of the application.

No new matter is presented.

Rejection under 35 U.S.C. 112[1]

The rejection of claims 1-4, 6, 8, 11, and 12 hereunder is traversed. The rejection alleges that there is only support for 15% or less and 19%, but not values between 15% and 19%, and that "about 15%" does not include 19%. Applicant need to have *verbatim* disclosure of ranges between 15% and 19% where such is inherently within the disclosure, and absent reasoning in the rejection why values between those values specifically disclosed are not within the written description of the invention. *In re Wertheim*, 191 U.S.P.Q. 90 (C.C.P.A. 1976); *in re Blaser*, 194 U.S.P.Q. 122 (C.C.P.A. 1977). The specification, as admitted in the rejection, specifically describes values of 12%, 15%, and 19%, and there is no reasoning why applicants were not in possession of the invention having intermediate values, other than a *verbatim* disclosure, which is not required by the statute.

Nevertheless, to reduce issues, claim 1 has been amended to recite the range between the values shown in Table 1 of the application. Accordingly, absent some reason why one of ordinary skill in the art would not be apprised that applicants' invention includes reflectance values between those specifically described, and why the written description of the various specific values is somehow deficient in describing intermediate values, this rejection should be withdrawn.

Rejections under 35 U.S.C. 103

Claims 1-4, 6, and 9-12 stand rejected as obvious over the combination of Friedman and Taga (GB 2122919), which rejection is respectfully traversed.

Friedman is directed to a reinforcing intermediate layer. As acknowledged in the final Office Action, this reference is silent as to surface treatments, especially those for preventing heat transmission but allowing some visible light. The rejection essentially alleges it would be "obvious to try" the coating of Taga on such a glass structure.

But Taga is directed specifically to glass for vehicles and buildings to avoid solar heating, using any ITO layer for reflecting heat and tin oxide for absorbing heat. This is evidenced further, as shown on the attached Structure Comparison table attached hereto, by the difference in reflectivities between the instant claims as Taga: namely, at 1500 nm this invention reflects 50+% while Taga reflects less than 50%, at 2500 nm this invention reflects 70+% while Taga reflects less than 70%, and at 3000 nm this invention reflects 80+% while Taga is completely silent.

These differences are shown graphically on the attached Figs. 1, 6, and 9 from Taga, where lines have been drawn at the wavelengths recited in applicants' claims and marked on the Taga reflectance line at those wavelengths. In Fig. 1,

the reflectance (Taga's line 104) at 15000Å is only about 25%, and extrapolating the line out to 25000Å (where Taga gives no data) the reflectance is less than the 70% presently claimed. Similarly, in Taga's Figs. 6 and 9, the values at 15000Å are only about 30% and 40%, respectively, whereas the present claims require 50%, and extrapolating line 104 in Figs. 6 and 9 out to 25000Å still gives values less than required by the present claims. Further, there is no data presented by Taga at 30000Å.

In addition, Taga discloses only the use of polybutyral resin for the intermediate layer, whereas the present claims now require a fluorocarbon or PET resin layer.


Accordingly, even if one were motivated to use the Taga surfaces on the Friedman glass, and were to fortuitously choose a fluorocarbon resin for the intermediate layer, based on the results provided in the Taga disclosure, the glass would not achieve the properties recited in the present claims.

Applicants also dispute that Taga is analogous art. *In re Deminski*, 796 F.2d 436 (Fed. Cir. 1986); *In re Wood*, 599 F.2d 1032 (CCPA 1979). There is a significant difference between preventing a car, home, or office from getting too hot versus preventing items from *combusting* due to heat transmission through glass; cars and offices do not burst into flames from the sun, so the cited art is not analogous. Moreover, the disclosure in Taga that their invention is applicable to peephole windows for furnaces is no more than a suggestion to experiment because there are no examples, disclosure, or suggestion how to modify the Taga compositions for use in an environment so much more extreme than merely being outdoors: the Taga disclosure is not enabling for glasses that protect against fire. The Taga reference does not "provide guidance for the modification of the heat wave shielding properties" to use such in furnaces, as alleged in the rejection, but rather only suggests that the properties of the heat can be modified

in some undisclosed way. In fact, Taga states that the "*nature* and thickness" (p. 13, ln. 49) of the layers can be changed to make the coatings suitable for very high temperature applications, but provides no teaching or guidance how the *nature* and thickness of the layers should be changed, and one can only guess at what is meant by the "nature" of the layers and how it should be changed. While ovens and furnaces may be considered analogous to those of structure fires, they are far afield from sole disclosure on preventing solar heating described by Taga.

Accordingly, all of the rejections should now be withdrawn.

Respectfully submitted,



Bradley N. Ruben, Reg. No. 32,058
Bradley N. Ruben, PC
463 First St., Suite 5A
Hoboken, NJ 07030-1859
201-239-0707 (fax -0734)
mail@rubenpatent.com

7 September 2004

CERTIFICATE OF MAILING OR TRANSMISSION – 37 CFR 1.8

I hereby certify that I have a reasonable basis that this paper, along with any referred to above, (i) are being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, or (ii) are being transmitted to the U.S. Patent & Trademark Office in accordance with 37 CFR § 1.6(d).

DATE: 7 September 2004

NAME: Brad Ruben

SIGNATURE: Brad Ruben